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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,222

10/24/2005

Toshihito Miyama

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EXAMINER

ECHELMAYER, ALIX ELIZABETH

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

04/02/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/554,222	Applicant(s) MIYAMA ET AL.	
	Examiner Alix Elizabeth Echelmeyer	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/13/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

1. This Office Action is in response to the arguments filed December 28, 2009 and the translation of JP 2003-122766; the translation was filed January 13, 2010. Claims 1-33 are pending. Claims 13-32 are withdrawn. Claims 1-12 and 33 are rejected finally for the reasons given below.

Information Disclosure Statement

2. The information disclosure statement filed January 13, 2010 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language, specifically EP 0 771 589. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

3. The rejection of claims 1, 6, 9, and 10 under 35 U.S.C. 102(a) as being anticipated by Nomura et al. (WO03/041091, with US 7,214,756 used as translation) is withdrawn in light of the priority documents filed January 13, 2010.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 3, 6, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Honma et al. (JP 2002-309016).

Honma et al. teach a proton-conductive membrane having a cross-linked support structure and a proton conducting structure (abstract). The proton-conducting agent contains acid, for example, sulfonic acid ([0050]).

As for claims 2, 3, and 6, the formula of the cross-linked structure of Honma is the same as the instant claims ([0022], [0031]).

With regard to claim 33, the membrane is for use in a fuel cell ([0002]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 5, and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma et al. in view of Curlier et al. (US 2004/0197613).

The teachings of Honma et al. as discussed above are incorporated herein.

With regard to claims 4 and 5, Honma et al. fail to teach the porosity of the membrane. The skilled artisan would recognize that the porosity of the membrane is result effective, since the membrane holds the electrolyte which allows for the fuel cell

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reaction to occur. The skilled artisan would be motivated to optimize the porosity of the membrane as is known in the art in order to improve the fuel cell. MPEP 2141 III (C).

Likewise, with regard to claims 7 and 8, the skilled artisan would be motivated to optimize the amount of cross-linkage, since the density of the membrane would affect the porosity.

As for claims 9-12, Honma et al. teach the proton conducting element containing sulfonic acid but fail to teach the claimed formula.

Curlier et al. teach a porous cross-linked membrane having a silicon-containing acid group attached to the cross-linked material ([0204]). When the silicon-containing acid group is attached to the cross-linked material of Honma et al., such as taught by Curlier et al., the structure of claim 12 results.

The skilled artisan would recognize that it would be desirable to attach the proton conducting material to the membrane, since it would prevent the material from becoming disturbed during the operation of the fuel cell.

Double Patenting

8. Claims 1, 6, 9 and 10 are rejected on the ground of nonstatutory double patenting over claims 1, 2, 8, and 9 of U. S. Patent No. 7,214,756 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

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common subject matter, as follows: the claims of '756 include the claimed cross-linked support with the claimed proton conducting structure (see above).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

9. Applicant's arguments filed December 28, 2009 have been fully considered but they are not persuasive.

Applicant argues that the membrane of Honma et al. does not have internally-formed pores. The examiner disagrees.

Based on the disclosure of Honma et al., the examiner finds that the membrane inherently has internally-formed pores. Honma et al. teach that the membrane is permeable ([0185]), and that when a coating is applied to the membrane, it partly penetrates into the membrane ([0197]).

Now, the skilled artisan will recognize that, while Honma et al. do not explicitly disclose pores, the membrane would necessarily be porous in order for the membrane to be permeable, or be penetrated by a coating.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alix Elizabeth Echelmeyer whose telephone number is (571)272-1101. The examiner can normally be reached on Mon-Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795

Alix Elizabeth Echelmeyer
Examiner
Art Unit 1795

aee